

REMARKS

Applicant hereby affirms the provisional election of Invention I and withdraws claims 15-28.

Reconsideration is requested of the objection to the drawings. The specification has been amended to refer to the subject reference numerals.

Reconsideration is requested of the rejection under section 112. The phrase "pan head washer type screw" is used in the specification at page 13, line 22. This is a definitive piece of hardware and leaves no question in the mind of one skilled in the art as to the type of hardware encompassed.

Reconsideration is requested of claims 1-3 over Bucher et al. Claim 1 has been amended to require a pipe receptacle separate from the smoking receptacle. Bucher et al.'s device does not have this feature. As such, claims 1-3 are patentable over Bucher et al.

Reconsideration is requested of the rejection of claims 1-10 and 12-14 over Hill. The basis for the rejection is the Office's assertion that Hill's column 3, lines 18-32 is disclosing a second embodiment of his invention which lacks the recess in the front face. However, one reviewing the reference as a whole would not think that this passage describes a separate embodiment. Consequently, Hill does not provide any teaching to one of ordinary skill as to an embodiment which does not have this recess in the front face. That this passage does not describe a separate embodiment is evident from the following:

1. Hill's original claims (copy enclosed) contained no claims which lacked the recess in the front face. Each of Hill's original independent claims 1 and 8 required this recess.

2. All of Hill's figures 1-5 include a recess in the front face, and he includes no figures which do not have this recess.
3. Hill's detailed specification in his application makes no mention of any embodiment lacking a recess in the front face.
4. The cited paragraph at column 3, lines 18-32 is describing an object, not an embodiment. This cannot fairly be deemed to be describing a separate embodiment, because it is clearly only describing additional objects among Hill's "laundry list" of objects. Each of the paragraphs immediately preceeding this paragraph discloses separate objects, not separate embodiments. Column 2, lines 55-60 discloses the object of providing the advantages of the prior art but not the disadvantages. This is not an alternative embodiment. Column 2, lines 61-64 discloses the object of ease and efficiency of manufacture. This is not an alternative embodiment. Column 3, lines 1-7 discloses the object of low cost. This is not an alternative embodiment. Column 3, lines 13-17 discloses the object of convenience. This is not an alternative embodiment. Then the passage cited in the Office action is introduced "Lastly, it is an object ...." This is neither intended to convey, nor would it be viewed as conveying, a separate physical embodiment any more than the previous paragraph discussing convenient storage was intended to convey or would be viewed as conveying a separate physical embodiment.

5. The recess in the front face, i.e., the "third recess," is first described at column 1, line 66. Thereafter the patent states (column 2, line 30), "There has thus been outlined, rather broadly, the more important features of the invention ...." This arrangement is consistent with a reading that all Hill's embodiments had the front recess, and is inconsistent with any reading that Hill had a second embodiment lacking the front recess.

The reference must be viewed as a whole for what it fairly teaches to one of ordinary skill in the art. MPEP 2142.02. It is respectfully submitted that one reading the Hill patent would not think Hill is describing two embodiments --- one with a front recess and one without a front recess. To conclude this would be a tortured reading of the reference which ignores its figures, claims, objects, and detailed description.

Inasmuch as Hill's only described embodiment has the front recess, applicant's claim 1 is patentable over Hill because claim 1 specifically requires that "the body has a constant peripheral contour in cross sections taken in any plane generally parallel to the body top and body bottom."

As explained at length in applicant's specification, this constant peripheral contour is critical to applicant's invention because it permits the use of a single blank of wood to manufacture a large number of bodies in a single pass in a single manufacturing operation using a multiple head milling machine. This advantage is not contemplated by the Hill patent, so there is no motivation in the Hill patent to omit his front recess to permit such manufacture. In fact, Hill states at column 4, lines 19-20 that his "main body portion is fabricated of a rigid plastic material." While Hill contemplates using metal, wood, or

plastic for his body portion (column 1, line 60), that he considered them to be interchangeable and that he used plastic in what is presumably his best mode underscores that he was not aware of the specific critical advantage that a constant peripheral contour provides in connection with smoking containers manufactured from wood. Accordingly, there is no motivation in Hill to employ this critical feature, so claim 1 cannot fairly be deemed to be obvious.

In further support of the unobvious nature of this constant peripheral contour, applicant notes that there are more than 30 prior art references of record, and not one of them discloses this feature. It is weighty and impressive that the only potential disclosure of this feature the Office was able to locate is in an unfairly contorted reading of Hill --- a reference in which all five figures clearly illustrate a non-constant peripheral contour.

In view of the foregoing, applicant respectfully submits that claim 1 is patentable because this constant peripheral contour is neither disclosed nor suggested by Hill. Claims 2-14 similarly include this requirement, and are therefore submitted to be patentable for these same reasons, and by virtue of the additional requirements they include.

With regard to claims 9 and 10, in particular, they specifically require a configuration which provides "unobstructed access to the smoking material receptacle opening and pipe receptacle opening simultaneously upon rotation of the lid to an open position." From the various positions shown in phantom in Hill's Fig. 2, it is evident that Hill's lid does not provide unobstructed access to both the first recess (pipe receptacle) and second recess (smoking material receptacle) simultaneously. And from his description at column 4, lines 38-51 it is evident

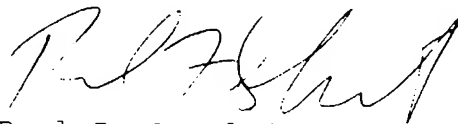
RCP 6014  
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that at least one of the first and second recesses is always closed or partially closed, i.e., obstructed.

With regard to claim 13, there is no suggestion by Hill to employ a generally arcuate contour. To assert that this is an obvious matter of design choice is a wholly unsupported modification of the prior art using applicant's claim as a guide. As described in the first full paragraph on applicant's page 12, this requirement is important to one of applicant's preferred embodiments because it permits full simultaneous exposure of both openings. Accordingly, even if the Office had made out a case of prima facie obviousness of this feature, such case is rebutted by evidence and disclosure of this special advantage not suggested by Hill.

In view of the foregoing, applicant respectfully requests issuance of a Notice of Allowance for claims 1-14..

Respectfully submitted,



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